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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,581	09/09/2003	William R. Wadleigh	1842.002US1	4658

7590 02/02/2007
Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

EXAMINER

CROSS, ALAN

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/659,581

Applicant(s)

WADLEIGH, WILLIAM R.

Examiner

Alan Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 9/9/03.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6517433 in view of Poole (US Patent #6375570). Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards a gaming system that has a video overlay of the reel symbols that when triggered shows a video presentation overlaying the symbols using a motion like video or animation. Patent '433 teaches all of the claimed invention including an overlay of game symbols that interact with the reel symbols, and the video display is triggered by a bonus condition or type of symbol. Patent '433 does not teach the apparatus on a portable video game system, a

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personal computer and a video game system using a television set, and does not fully teach full motion video. Poole teaches showing a overlay over certain symbols because of a triggering condition, and Poole also teaches full motion video (col. 2, 15-30), Poole also teaches the apparatus capable of a game with multiple symbols and overlay to be on a portable video game system, a personal computer and a video game system using a television set (col. 4, 35-42). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Patent '433 with Poole so that the overlays could be on a portable gaming device or a personal computer, and the overlay elements to be in full motion video. This would allow for greater player entertainment and excitement.

Claim Objections

Claim 26 is objected to because of the following informalities: Claim 26 is dependent to its self, because of previous claim structure it was interpreted to be dependant upon claim 24. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims rejected under 35 U.S.C. 102(e) as being anticipated by Loose (US Patent #6517433)

Regarding claim 1,4,7,17,24,32,38,44,47: Loose discloses a method comprising: displaying a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine, wherein the at least one symbol element remains at least partially visible while the supplemental graphical element is displayed. Poole also discloses an apparatus using processors displaying multiple images with a triggering event to display a video event overlaying the elements (col. 2, 25-33, col. 4, 58-67, col. 5, 52-67).

Regarding claim 2,5,45: Loose discloses the method of claim 1, further comprising: displaying the at least one symbol element; determining, based on the at least one symbol element, whether a triggering event has occurred; and if a triggering event has occurred, identifying the supplemental graphical element as a set of video images (col. 4, 58-67).

Regarding claim 3,6,8,18,25,33,39,46,48: Loose discloses the method of claim 1, wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video (col. 4, 58-67).

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Regarding claim 9,19,26,40,49: Loose discloses the apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed by causing at least a portion of a video image within the set to be displayed within a first set of pixels within a game element area, such that a game element image associated with the game element area is at least partially visible (fig. 9b)

Regarding claim 10,11,20,21,27,28,35,36,41,42,50,51: Loose discloses the apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque and semi transparent overlay over one or more of the multiple game element images (col. 5, 23-30).

Regarding claim 12,22,29,34,37,43,52: Loose discloses the apparatus of claim 7, wherein the one or more processors further: determines whether a video image is associated with an alteration of a game element image within a game element area; and if the video image is associated with the alteration, causes an altered image to be displayed in the game element area (col. 4, 58-67, col. 5, 1-10).

Regarding claim 13-16: Loose discloses The apparatus of claim 7, wherein the apparatus forms a portion of a wagering game machine, portable battery powered video game system, a personal computer , and a video game system that interacts with a television set; where the apparatus further comprises: a display device, operatively coupled to the one or more processors (fig. 11).

Regarding claim 23: Loose discloses the electronic slot machine of claim 17, further comprising: a money/credit input/output (I/O) device for enabling a player to

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obtain credits; and player input devices that enable the player to specify a bet and to initiate a spin of the multiple reels (col. 3, 26-41).

Regarding claim 30,31: Loose discloses the method of claim 24, wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a display device coupled to the wagering game machine (col. 1, 40-54).

Claims rejected under 35 U.S.C. 102(b) as being anticipated by Poole (US Patent #6375570)

Regarding claim 1,4,7,17,24,32,38,44,47: Poole discloses a method comprising: displaying a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine, wherein the at least one symbol element remains at least partially visible while the supplemental graphical element is displayed. Poole also discloses an apparatus using processors displaying multiple images with a triggering event to display a video event overlaying the elements (col. 2, 14-30, col. 2, 40-49, col. 4, 25-41).

Regarding claim 2,5,45: Poole discloses the method of claim 1, further comprising: displaying the at least one symbol element; determining, based on the at least one symbol element, whether a triggering event has occurred; and if a triggering

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event has occurred, identifying the supplemental graphical element as a set of video images (col. 2, 40-55).

Regarding claim 3,6,8,18,25,33,39,46,48: Poole discloses the method of claim 1, wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video (col. 2, 17-31).

Regarding claim 9,19,26,40,49: Poole discloses the apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed by causing at least a portion of a video image within the set to be displayed within a first set of pixels within a game element area, such that a game element image associated with the game element area is at least partially visible (col. 6, 12-25).

Regarding claim 10,11,20,21,27,28,35,36,41,42,50,51: Poole discloses the apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque and semi transparent overlay over one or more of the multiple game element images (col. 6, 12-20).

Regarding claim 12,22,29,34,37,43,52: Poole discloses the apparatus of claim 7, wherein the one or more processors further: determines whether a video image is associated with an alteration of a game element image within a game element area; and if the video image is associated with the alteration, causes an altered image to be displayed in the game element area (col. 7, 30-50).

Regarding claim 13-16: Poole discloses The apparatus of claim 7, wherein the apparatus forms a portion of a wagering game machine, portable battery powered video game system, a personal computer , and a video game system that interacts with a television set; where the apparatus further comprises: a display device, operatively coupled to the one or more processors (col. 4, 36-42).

Regarding claim 23: Poole discloses the electronic slot machine of claim 17, further comprising: a money/credit input/output (I/O) device for enabling a player to obtain credits; and player input devices that enable the player to specify a bet and to initiate a spin of the multiple reels (col. 4, 46-59, col. 5, 1-9).

Regarding claim 30,31: Poole discloses the method of claim 24, wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a display device coupled to the wagering game machine (col. 4, 26-41).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lemay et al. (US Pat # 6942574) discloses a method and apparatus for presenting video content on a gaming machine.

Jackson et al. (US Pub # 2003/0064800) discloses pop up windows that overlay over game symbols and allow a user to change options regarding those symbols.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cross whose telephone number is 571-272-5529. The examiner can normally be reached on 8-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARC 571-272-5529


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